

REMARKS:

Claims 1-10 have been rejected under 35 U.S.C. § 103 as being unpatentable over Ledman in view of Kough. Appellant has argued that the Examiner has not shown a *prima facie* case of obviousness because each and every limitation of independent claims 1 and 5 would not be present if Ledman and Kough were combined. Specifically the combination would not teach "including a request that the package remain unopened but suggesting that the unopened package is filled with the positive feeling." In the Examiner's Answer, the Examiner admits that "Ledman, et al. in view of Kough discloses all of the structure defined by the applicant in the claims except for the particular message on the note." (Examiner's Answer Page 7). The Examiner also asserts that "the words appearing on the note/card are not functionally related to the substrate (card/note)" and that "the printed matter is simply printed onto the note card."

(Examiner's Answer Page 7). Thus, "there is no functional relationship between the printed matter (message) and the substrate (note) which carries it." (Examiner's Answer Page 7).

The Examiner has maintained the rejection based primarily on the grounds that "[p]rinted matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the Applicant's case, there is no functional relationship between the printed matter (message) and the substrate (note) which carries it." (See Examiner's Answer, pg. 4, lines 6-9).

The Applicant respectfully disagrees. In Gulack, the Federal Circuit concluded that "the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate". Id. at 1386. In making this determination, the Court noted that the PTO must consider all claim limitations when determining patentability of an invention over the prior art; Id. at 1385; and the PTO may not disregard claim limitations comprised of printed matter. Id. at 1384.

Applicant first asserts that when the claims are considered as a whole, there is a functional relationship between the "printed matter" and the "substrate". To establish a functional relationship the "printed matter" must provide information about the substrate or what is contained in the substrate. (See, e.g. In re Levin, 107 F.3d 30 (Fed. Cir. 1997)). For example, in Levin the Federal Circuit found that the relationship between the color coded expiration date indicia (printed matter) on a container or pharmaceutical product (substrate) created a functional relationship as the indicia provided information about what was contained in the substrate.

Like Levin, the claims of the present application, when read as a whole require that the note suggest "that the unopened package is filled with the positive feeling". Therefore, by conveying information about the content of the package, the "printed matter" has a functional relationship with the package and the only question is whether the functional relationship is new and unobvious.

The Applicant asserts that the functional relationship of the claims is novel and non-obvious. Specifically, claim 1 requires, in part, "a request that the package remain unopened". In contrast, neither Kough or Ledman teach this limitation.

More specifically, Kough is silent as to any request regarding the unopening of the package and instead is directed toward cards customized for design coordination with any item, container, or wrapping paper.

Ledman actually teaches away from Applicant's invention as it expressly requests that one open the box in order to receive varied amounts of "love". (See Fig. 2). A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that the Applicant took. Here, upon reviewing Ledman, one would have been led down the path of requesting that the box be opened for varied increments of time, instead of requiring a request that the package remain unopened. The only way to arrive at the claimed invention based on the teachings of Kough and Ledman is to impermissibly use Applicant's disclosure as a template. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Fitch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

Therefore, as a functional relationship is present, and the functional relationship is new and not obvious, the Applicant respectfully requests that the Examiner's rejections of claims 1-10 be reversed.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

Reply Brief to Examiner's Answer dated June 17, 2005

Any fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'TJ Zarley', written over a horizontal line.

Timothy J. Zarley

Reg. No. 45,253

ZARLEY LAW FIRM, P.L.C

Capital Square

400 Locust Street, Suite 200

Des Moines, IA 50309-2350

Phone No. (515) 558-0200

Fax No. (515) 558-7790

Customer No. 34082

Attorneys of Record

- JLH/bjs/jlk -